

## REMARKS

### **I. Status of Claims**

Claims 1, 3, 6, 9, 11-15, 17-30 and 48-55 are pending in the application, the remaining claims having been canceled. Claims 1, 3, 6, 9, 11-15, 17-30 stand rejected under 35 U.S.C. §112, first and second paragraphs. The specific grounds for rejection, and applicants' response thereto, are set out in detail below.

### **II. Rejection under 35 U.S.C. §112, First Paragraph**

Claims 1, 3, 6, 9, 11-15, 17-30 stand rejected under 35 U.S.C. §112, first paragraph as allegedly lacking an adequate written description. The rejections turn on the absence of sequence information (total or partial) from the claims. Applicants traverse, but in the interest of advancing the prosecution, the claims have been amended to combine the sequences for the recited elements of the transactivation domain (sequence from between position 27 and position 270 of SEQ ID NO:2), the zinc finger domain (sequence from between position 290 and position 374 of SEQ ID NO:2), and the proline rich domain (sequence from between position 27 and position 192 of SEQ ID NO:2).

The examiner has indicated that even claims containing partial sequence information do not adequately describe that which the inventors possessed at the time of filing. However, these regions are not simply random fragments of the Osterix polypeptide. To the contrary, these are conserved regions, and little homology is observed outside these recognized structures. Thus, it is perfectly logical, as one of ordinary skill in the art would appreciate, that variation in other regions of Osterix would be expected. As such, by combining these partial structural limitations in claim 1, applicants submit that the claims now reflect a structural description of the

polypeptide that the skilled artisan would recognize as (a) distinct from the prior art, (b) representing the functional portions of the molecule, and (c) in the possession of the inventors at the time of filing.

Thus, there is here no “failure of the patent to describe the claimed sequences by anything other than their function,” (*Enzo Biochem, Inc. v. Gen-Probe Inc.*, 285 F.3d 1013, Fed. Cir. 2002), as structures are provided. Moreover, as the requirement of MPEP §2163, that §112 is “to put the public in possession of what the applicant claims as the invention,” has been satisfied. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

## **II. Rejection under 35 U.S.C. §112, Second Paragraph**

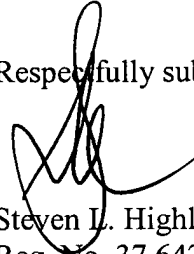
Claims 1, 3, 6, 9, 11-15, 17-30 stand rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite. Applicants submit that this issue is essentially the same as that set forth for the §112, first paragraph rejection, and thus the response provided above is incorporated by reference herein. Reconsideration and withdrawal of the rejection is therefore respectfully requested.

## **IV. Conclusion**

In light of the foregoing, applicants respectfully submit that all claims are in condition for allowance, and an early notification to that effect is earnestly solicited. Should Examiner McKelvey have any questions regarding this response, a telephone call to the undersigned is invited.

Please date stamp and return the accompanying postcard to evidence receipt of these documents.

Respectfully submitted,



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